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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,783	11/21/2000	Sadashiv Adiga	182.1001.02	8548

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/717,783

**Applicant(s)**

ADIGA ET AL

**Examiner**

Narayanswamy Subramanian

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response to applicant's communications filed on November 25, 2003. Claims 1-26 are pending. Applicant's provisional election, with traverse, of Group II comprising claims 10-26 has been entered. Claims 1-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action. The response to arguments regarding restriction requirements and rejections are stated below.

#### ***Response to Restriction Requirement***

2. Applicant's arguments in regards to the restriction requirements have been considered but are non persuasive for the reasons given below. As discussed in the last office action (Paper #5) the two groups are distinct and have different features. For the purpose of clarification the following reasons are in order. Invention I (Claims 1-9) pertains to an apparatus whereas Invention II (claims 10-26) pertains a method. The method of Invention II can be performed with an apparatus different from the one claimed in Invention I. Hence the method of Invention II has a utility different from the apparatus of Invention I. Hence the two groups are considered as separate inventions that can be used as sub-combinations, even though they are not classified into a separate class or sub-class. These inventions require a separate search. Hence the restriction of the claims is maintained.

***Claim Rejections - 35 USC § 101***

3. The claims 10, 12, 13, 16, and 19-26 of the elected invention are directed to non-statutory subject matter. Claim 10 is drawn to a method for automated negotiation that is not tied to any technological art. Similarly the dependent claims 12, 13, 16, and 19-26 are not tied to any technological art. Claims 10, 12, 13, 16, and 19-26 of the invention are directed merely to human making mental computations and manually plotting results on paper, and thus are nothing more than an abstract idea, which is not tied to any technological art, and is not a useful art as contemplated by the constitution. (See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished))

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 11-13, 15 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 11-13 cite the step of “identifying prospective partners” which is not present in claim 10. There is no antecedent basis for this limitation in claims 11-13. Claim 15 cites the limitations of “specifying terms that can be varied; and specifying a range over which said terms as can be varied” which is vague and unclear. The metes and bounds of these limitations are unclear to one with ordinary skill in the art. Claim 21 cites the limitation “rejecting the offer of making of making a counter offer” which is also vague and unclear. Clarification is required.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US Patent 5,924,082).

With reference to claims 10 and 20 and 21, Silverman teaches a method for automated negotiation, including steps for: identifying one or more parties; setting the parameters of said automated negotiation; sending an invitation to said automated negotiation to one or more parties; making an offer in response to said invitation (See Silverman Claim 39) and storing information in a database (See Silverman Column 7 lines 31-33) Notifying potential counter-parties is interpreted to include the step of sending an invitation to negotiation to one or more parties.

Silverman does not explicitly teach the step of responding to said offer including accepting the offer, rejecting the offer or making a counter offer by the party that sent said invitation.

Official notice is taken that the step of responding to an offer including accepting the offer, rejecting the offer or making a counter offer by the party that sent said invitation is old and well known in the art. This step facilitates negotiation between two parties and to agree on a settlement in a timely manner.

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It would have been obvious to one with ordinary skill in the art at the time of invention to include this step to the invention of Silverman. The combination of the disclosures taken as a whole suggests that it would have helped the two negotiating parties reach an agreement in a timely manner.

With reference to claims 11-13, Silverman teaches the step wherein identifying prospective counter-parties is performed automatically by a computer program that searches a database (See Silverman Column 7 lines 31-45, storage of bids/offers with their corresponding parameters implies a database and the matching step implies searching the database); identifying prospective counter-parties is performed by the initiator of said automated negotiation (See Silverman Column 3 lines 40-43 and Column 7 lines 36-42); identifying prospective counter-parties includes setting various parameters for access control and preferences so as to create private negotiations and private directories (See Silverman Column 3 lines 36-50, Column 8 line 66 – Column line 14) The second parameters are interpreted to include various parameters for access control and preferences so as to create private negotiations and private directories.

With reference to claims 14-15, Silverman teaches a method of claim 10, wherein said step of setting the parameters is performed by an initiator of said automated negotiation through a series of interactions with a computer program (See Silverman Column 7 lines 25-30); where in said series of interactions includes defining the type of said automated negotiation (See Silverman Column 3 lines 55-60); specifying terms that can be varied; and specifying a range over which said terms as can be varied (See Silverman Column 1 lines 18-22, Column 5 lines 49-53 and Claim 14)

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With reference to claims 11-18, Silverman teaches a method of claim 10, wherein said invitation includes information included in said parameters (See Silverman Column 4 lines 28-49); where in said invitation is sent to said one or more parties using a computerized communication system (See Silverman Abstract); wherein said computerized communication system includes a wireless transmitter and receiver (old and well known in the art).

With reference to claim 19, Silverman teaches a method of claim 10, wherein said step of making an offer is performed by a party other than the sender of said invitation (See Silverman Column 4 lines 4-12) The invitation is sent by the matching system and the offer or counter offer is made by the bidding parties.

With reference to claims 22-26, Silverman teaches a method of claim 10, wherein said step of storing information includes information concerning said automated negotiation (See Silverman Column 7 lines 30-33); step of storing information includes information regarding the relative performance of one, or more parties to said automated negotiation (See Silverman Column 7 lines 25-30, ranking information includes relative performance); step of storing information is independent of any particular outcome of said automated negotiations (See Silverman Column 7 lines 25-30, storing entered bids and offers imply storing information independent of any particular outcome); information is stored on a relational database (inherent in the disclosure) or an object-oriented database (old and well known in the art).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is

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(703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
February 16, 2004

~~Richard Weisberger~~  
Primary Examiner